

RD



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,677	11/07/2002	Muhammed Majeed		9298

33048 7590 04/07/2004
SABINSA CORPORATION
121 ETHEL ROAD WEST, UNIT 6
PISCATAWAY, NJ 08854

EXAMINER

ZUCKER, PAUL A

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/065,677	Applicant(s) MAJEED ET AL.	
	Examiner Paul A. Zucker	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/7/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1621

DETAILED ACTION

Current Status

1. This action is responsive to Applicants' amendment of 12 January 2004.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-11 remain pending.
4. Claims 9-11 have been withdrawn.
5. The objections to the claims set forth in paragraphs 1-3 of the previous Office Action in Paper No 2 are withdrawn in response to Applicant's amendment.
6. The rejections under 35 USC § 112, second paragraph, set forth in paragraphs 4 - 12 of the previous Office Action in Paper No 2 are withdrawn in response to Applicant's amendment.
7. The rejection under 35 USC § 102(b) set forth in paragraph 13 of the previous Office Action in Paper No 2 is withdrawn as moot in view of Applicants' withdrawal of the relevant claims.
8. The rejection under 35 USC § 103 set forth in paragraph 14 of the previous Office Action in Paper No 2 is withdrawn as moot in view of Applicants' withdrawal of the relevant claims.

Ex parte Quayle

This application is in condition for allowance except for the following formal matters:

9. The amendment filed 12 January 2004 is finally objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no

amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- a. Amendment, page 2: The amendments to the title and paragraph [0004] constitute new matter because they change the concept of the invention as filed and considerably narrow the scope of the original disclosure.
- b. Amendment, page 2: The addition of the two references in paragraphs [0007.1] and [0007.2] constitute new matter because they were not present in the application as filed.
- c. Amendment, page 3: The amendments to paragraph [0011] constitute new matter because they change the invention to the extent that the originally filed method for production of L-Chloroalanine methyl ester hydrochloride has been changed from the use of SOCl_2 to PCl_5 .
- d. Amendment, page 3: The amendments to paragraph [0013] constitute new matter because they change the invention to the extent that the application, as originally filed, included Se-allyl and Se-aryl selenocysteines.
- e. Amendment, pages 3-4: The amendment to paragraph [0014] constitutes new matter because they change the invention to the extent that the application, as originally filed, included Se-allyl and Se-aryl selenocysteines.
- f. Amendment, page 4: The amendment to paragraph [0015] constitutes new matter because they change the invention to the extent that the application, as originally filed, included Se-allyl and Se-aryl selenocysteines.

Art Unit: 1621

- g. Amendment, page 4: The deletion of paragraphs [0020], [0021] and [0023] constitutes new matter because they change the invention to the extent that the application, as originally filed, included a modified method for the production of L-Chloroalanine methyl ester hydrochloride which is removed by Applicants' deletion. NOTE: Applicants are reminded to correctly renumber the deleted experimental procedures and all subsequent experiment numbers.
- h. Amendment, page 6: The amendment to paragraph [0032] constitutes new matter because it changes the invention to the extent that the originally filed method for production of L-Chloroalanine methyl ester hydrochloride using SOCl_2 has been deleted.

Applicant is required to cancel the new matter in the reply to this Office Action.

10. Applicants are required to cancel withdrawn claims 9-11.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Conclusion

11. Claims 1-11 are pending. Claims 1-8 are allowed.

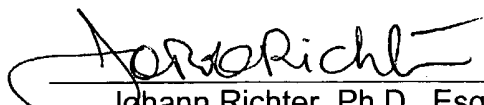
Art Unit: 1621

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul A. Zucker, Ph. D.
Patent Examiner
Technology Center 1600


Johann Richter, Ph.D., Esq.
Supervisory Patent Examiner
Technology Center 1600